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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,952	01/02/2008	Takuji Kataoka	46884-5517 (232124)	6694
55694 7590 10/12/2011 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209				
EXAMINER				
HANDY, DWAYNE K				
ART UNIT		PAPER NUMBER		
1773				
NOTIFICATION DATE		DELIVERY MODE		
10/12/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbi.com

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Office Action Summary

Application No.

10/594,952

Applicant(s)

KATAOKA, TAKUJI

Examiner

DWAYNE K. HANDY

Art Unit

1773

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 12 and 13 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 12 and 13 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-853)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/23/11 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over He et al. (US 2003/0049862) in view of Krahn et al. (US 2002/0022274). This

rejection was applied to claims 10-17 in the previous Office Action (mailed 04/28/11). It remains in effect for claims 12 and 13. Please see Response to Arguments below.

Response to Arguments

4. Applicant's arguments filed 08/23/11 have been fully considered but they are not persuasive.
5. Applicant has argued that He does not teach a masking member having a light shielding part (Page 6 of Arguments). The Examiner respectfully disagrees. As noted by Applicant and by the Examiner (in the previous Office Action), the Examiner is relying on the microcolumn element as part of the claimed masking member. See Paragraph 4 of the Previous Office Action. He, in Paragraph [0058], teaches that the microcolumn may be coated with a gold metal. The gold layer would provide light shielding.
6. Applicant has also argued that the device of He does not include any structure disclosing that a specimen is disposed on the bottom of the well (Page 7 of Arguments). The Examiner submits this argument is beyond the scope of the claim as this feature is not recited in the claims. The claims recite "the liquid being located on the opposite side of the bottom of the associated well across the measurement object". The Examiner submits that in the combined device of He and Krahn, the addition of liquid reagents and/or dye as in Krahn would result in the liquid mixing with the specimen on the being

located opposite of the bottom of the associated well across the measurement object as required by the claim. See Figure 6-7 and Paragraphs [0039] – [0042] of Krahn.

7. Applicant has also argued that He does not teach a light shielding member that extends to contact the inner portion of the well. The Examiner concedes that this feature is not taught by the single reference He. However, the Examiner also notes – as does Applicant on Page 7 of Arguments - that Krahn teaches a light shielding element comprised of pigments and/or beads. The pigments or beads DO extend across the entirety of the well to contact the inner walls of the wells. When the microcolumn and pigments/beads are both in the well – as they would be in the combined device - the microcolumn would contact the pigments with both elements combining to form the light shielding member. Therefore, the Examiner submits that the combination of He and Krahn would result in a light shielding member that extends across the entirety of the well to contact the inside walls of the well as required by the amended claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 11:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DWAYNE K HANDY/
Examiner, Art Unit 1773

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1773

October 3, 2011